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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/291,983	04/15/1999	JAMES A. MARTIN	PM-259035	2911

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EXAMINER

DEXTER, CLARK F

ART UNIT


PAPER NUMBER

3724

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

IC

<b>Office Action Summary</b>	Application No. <b>09/291,983</b>	Applicant(s) <b>Martin et al.</b>	
	Examiner <b>Clark F. Dexter</b>	Art Unit <b>3724</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Dec 7, 2001
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above, claim(s) 10-15 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 16, and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |  |  |
|--|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 20) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. The response filed December 7, 2001 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-9, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over David, pn 3,329,186, in view of Wells, pn 679,653 (hereafter Wells '653).

David discloses a hacksaw with almost every structural limitation of the claimed invention but lacks the frame member having an arcuate portion extending substantially the entire length between the forward end portion and the maximum height portion. Wells '653 discloses a frame member with such an arcuate portion and teaches that the curved characteristic and the tubular characteristic combined provide a desired degree of elasticity along with the requisite strength to strain the saw blade for cutting. It is noted that the I-beam-shaped frame member of David is considered an equivalent strengthening characteristic of the frame member of David. Further, the Examiner takes Official notice that it is old and well known in the art, particularly the mechanical arts, that corners or sharp bends or the like create stress risers wherein stress is concentrated in a

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relatively small area of a component which may lead to premature failure of the component in that area. It is further known that to alleviate this problem, the material in that area must be either “overdesigned” (i.e., designed with stronger material or enough additional material to provide the needed extra strength and endurance for a sufficiently long life for the component) or designed more “efficiently” without such corners or curves to eliminate the stress concentration areas which usually provides benefits such as requiring less material resulting in a lighter weight component. Therefore, it would have been obvious to one having ordinary skill in the art to provide the frame member of David with the claimed arcuate portion for providing an efficient design along with the other well known benefits described above as well as those taught by Wells.

Further, the specifics of the arcuate portion as defined in the dependent claims, specifically the specific measurements of claims 6-9, would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3-9, 16 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. Des. 403,224 to Martin et al. in view of Hepworth et al.

Martin et al. discloses a hacksaw frame and lacks an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device. However, to provide a blade and mounting structure to mount the blade onto the frame is inherent in the invention of Martin et al. since it is a hacksaw frame which is intended to be used with such structure. Further, to provide a tensioning structure as one of the mounting structures is old and well known in the art as evidenced by Hepworth et al. for facilitating removal and assembly of the blade onto the saw frame. Therefore, it would have been obvious to one having ordinary skill in the art to provide an elongated blade attached to the frame by a first mounting structure and a second mounting structure in the form of a tensioning device to perform the intended use of the frame and for the well known benefits including that described above.

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***Response to Arguments***

6. Applicant's arguments filed December 7, 2001 have been fully considered but they are not persuasive.

Regarding the rejections over the Appendix A catalog, Product ID No. 20-001, applicant was requested in paragraph 10 of the previous Office action to provide additional information about the document and to state whether this document is prior art. In the first sentence on page 2 of the response, applicant states regarding this document that "the Applicant is stating for the record that the product catalog is not prior art and requests all rejections based on the same to be withdrawn." In view of applicant's statement, the prior art rejections based on this document have been withdrawn. However, applicant is still requested to provide additional information about the document, particularly a publication date therefor.

In the fourth paragraph on page 2 of the response, applicant argues that "the Examiner has failed to cite any evidence in the record that provides a motivation or suggestion for combining David and Wells." The Examiner respectfully disagrees. First, Wells explicitly teaches that the curved characteristic along with the tubular characteristic combined provides a desired degree of elasticity along with the requisite strength to strain the saw blade for cutting. It is clear to one having ordinary skill in the art that the desired degree of elasticity is due in large part to the curved characteristic, and the requisite strength is due in large part to the tubular characteristic. Further, the Examiner stated that I-beam structures and tubular structures are well known equivalent structure-strengthening characteristics. There are many references/publications that

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teach such equivalency. U. S. Patent 5,406,760 to Edwards is provided to show just one example of such a teaching. Specifically, Edwards teaches that in support structures, round tubes and I-beam members are equivalents (see the last paragraph of the specification in column 13). The saw frame of the present invention is clearly a specific type of support structure and thus such a teaching is clearly analogous and thus pertinent. Second, the Examiner stated that the advantages/benefits of a curved versus bent frame structure are old and well known in the art and gave examples of such known advantages/benefits. Such a teaching, although not explicitly taught by the applied prior art, is taught by the prior art of record taken as a whole. Thus, it is respectfully submitted that the Examiner has provided a motivation or suggestion for combining David and Wells, and thus has met the first prong of the three-pronged obviousness test.

In the third paragraph on page 3 of the response, applicant argues that “Wells teaches away from the claimed invention, and thus there would be no suggestion to combine the I-beam of David with the arcuate frame of Wells.” The Examiner respectfully disagrees, and for at least the reasons described in the above paragraph, the Examiner’s position is that the prior art not only does not teach away from the claimed invention, but rather teaches/suggests the claimed invention.

Further, in the paragraph bridging pages 3 and 4 of the response, applicant argues that “one would not be motivated to change to tubular shape of the Wells frame member. Stated differently, substituting the I-beam frame member of David for the tubular frame member of Wells would negate the teachings of Wells, namely the teaching that a tubular frame member is

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essential.” The Examiner respectfully disagrees with applicant’s reasoning and submits that applicant’s arguments are not persuasive. Further, and more importantly, applicant’s argument does not address the prior art rejection of record; that is, the rejection states that it would be obvious to one having ordinary skill in the art to use the teachings of the prior art, taken as a whole, particularly the teachings of Wells, to modify the saw disclosed by David. There is no suggestion by the Examiner to modify the saw of Wells as suggested by applicant. Therefore, the Examiner respectfully submits that the prior art teaches or suggests every structural limitation of the claimed invention and meets the three-pronged test of obviousness, and thus the subject prior art rejection must be maintained.

In the second paragraph on page 4 of the response, applicant argues that “[B]ecause the claims of the present invention are not limited to the ornamental appearance of a hacksaw, and instead are directed to the structure of the hacksaw frame member without regard to the specifics of its ornamental appearance, it is submitted that the claims of the present application are not obvious variations of the claim of the ‘224 Design patent.” The Examiner respectfully disagrees. The claim of the Design patent clearly includes the frame and the configuration thereof, and the claims of the present patent application are drawn in large part to the frame and its configuration. Because the claim of the Design patent and the claims of the present application are directed to the same subject matter, the obvious-type double-patenting rejection must be sustained. Applicant’s attention is directed to MPEP 804, section IIB3 entitled “Design/Plant - Utility Situations.”



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***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', written in a cursive style.

**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
January 18, 2002